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| 09/410,494      | 09/30/1999  | KURT W. PIERSOL      | 74451.P107          | 6948             |

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07/01/2002

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EXAMINER

WON, YOUNG N

ART UNIT PAPER NUMBER

2155

DATE MAILED: 07/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/410,494

Applicant(s)

PIERSOL ET AL.

Examiner

Young N Won

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-27 & 29-31 have been examined.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-8, 12-20, 24-27, and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Walls et al. (U.S. Pat. No.5848410).

As per claims 1 and 13, Walls teaches a method (see col.8 lines 5: system and method) comprising and a machine-readable medium having stored thereon sequences

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of instructions that, when executed by one or more processors (see col.9 lines 39-51), cause: generating, automatically (see col.8 lines 10-11) with an electronic system (see col.9 line 35: network environment and Fig.1), a first search request (see col.26 lines 25-26: search one or more files...at one or more intervals) in response to an original search request, the first search request to cause a search to be performed on electronic documents (see col.1 lines 39-42 and col.3 lines 17-18: web page) unconsciously captured (see col.12 lines 57-67 to col.13 lines 1-4) by a local network device (see col.10 lines 15-16: output devices), the search of the electronic documents unconsciously captured to be performed according to search parameters of the original search request (see col.11 lines 25-39); and generating, automatically with the electronic system, a second search (see col.26 lines 25-26: search one or more files...at one or more intervals) request in response to the original search request, the second search request to cause a search to be performed on electronic documents available via a network portal (see col.10 lines 23 & 36: network interface) of an external network (see col.1 lines 26-29: Internet) according to the search parameters of the original search request.

As per claims 2 and 14, Walls further teaches wherein the local network device comprises a file management appliance (see col.3 lines 52-55: continuous indexer).

As per claims 3 and 15, Walls further teaches wherein the file management appliance generates the first search request and the second search request (see col.3 lines 64-67: at least, to col.4 lines 1-2, and col.11 lines 23-25 & 35-39).

As per claims 4 and 16, Walls further teaches wherein the file management appliance performs a search of the unconsciously captured electronic documents in response to the first search request (see col.12 lines 57-67 to col.13 lines 1-4).

As per claims 5 and 17, Walls further teaches an Internet portal (see col.10 line 40: Internet, and Fig.1 no.150) performs a search of the electronic documents available via a network portal 9 see col.10 lines 23 & 36: network interface, and Fig.1 no.128) of an external network in response to the second search request.

As per claims 6 and 18, Walls further teaches wherein the first search request, and the second search request, are generated by a portal appliance (see col.3 lines 52-55: continuous indexer) in response to the original search request.

As per claims 7 and 19, Walls further teaches generating a search report based on results from the first search request and the second search request (see. col.5 lines 49-52).

As per claims 8 and 20, Walls further teaches wherein the search report is a Hypertext Markup Language (HTML) document (see col.1 lines 29-32 & 59-62, col.4 lines 23-24, and col.12 lines 29-30).

As per claims 12 and 24, Walls further teaches generating a third search request in response to the original search request, the third search request (see col.26 lines 25-26: search one or more files...at one or more intervals) to cause a search to be performed on electronic documents available via a second network portal (see col.10 lines 37-39, nodes may consist of more host servers, whereby in lines 35-36, include via

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a network interface) of the external network according to the search parameters of the original search request.

As per claim 25, Walls teaches of an apparatus comprising: a device (see col.10 lines10-14) to automatically (see col.8 lines 10-11) capture electronic documents from the network (see col.4 lines 20-21); and an application (see col.9 lines 39-51) to search the captured electronic documents (see col.1 lines 39-42 and col.3 lines17-18: web page) in response to a search request, wherein the application also generates an external document search request (see col.11 lines 57-61) in response to the search request, the external document search request to generate a search of electronic documents from an external network (see col.1 lines 26-29: Internet).

As per claim 26, Walls further teaches that the application is executed by the device (see col.9 lines 39-43).

As per claims 27 and 29, Walls further teaches that the application is executed by a second device coupled to the device wherein the search of captured electronic documents is performed by the second device (see col.10 lines24-34).

As per claims 30 and 31, Walls further teaches that external document search is performed by an Internet portal (see col.10 line 40: Internet, and Fig.1 no.150) wherein the search of captured electronic documents is performed by the device (see col.10 lines 24-34).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walls et al. (U.S. Pat. No.5848410) as applied to claims 1, 7, 13, and 19 above, and further in view of MacKenty et al. (U.S. Pat. No.6088675). Walls teaches all the limitations of claims 9 and 21, except that the search report is an Extensible Markup Language (XML) document. MacKenty teaches that a report can be an Extensible Markup Language (XML) document (see col.1 lines 19-21). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of MacKenty within the system of Walls, by using XML documents within the search report, because XML documents are used for technical documentations. Thus, if technical searches were widely performed, one would employ an XML document as the standard.

4. Claims 10, 11, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walls et al. (U.S. Pat. No.5848410) as applied to claims 1, 7, 13, and 19 above, and further in view of Rakavy et al. (U.S. Pat. No.5913040). Walls teaches

all the limitations of claims 10, 11, 22, and 23, except that the search report comprises an advertisement selected based on the first search request and based on analysis of documents indicated by search results. Rakevy teaches of a search report comprises an advertisement selected based on the first search request and based on analysis of documents indicated by search results (see col.1 lines 20-22 & 35-42). It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to employ the teaching of Rakevy within the system of Walls, by employing search reports comprising an advertisement generated from search results, because this would allow searching systems like Walls' to generate revenue from companies who wish to advertise to customers using such systems, in similar fashion to web site advertising methods currently employed.

### ***Response to Arguments***

5. Claims 1-8, 12-20, 24-27, and 29-31 are still anticipated by Walls.

As noted, Walls discloses that indexing documents can be "remote" or "local" (see col.19 lines 5-10), and he also teaches that the system can be implemented throughout a plurality of networks (see col10 lines 35-51), thus the searching can be performed on external network or local network, respectively. Additionally, Walls teaches that the "indexer is configured to search one **or more** files (1, 2, 3, ...n files) within **at least** one file system ("remote" or "local") at one **or more** intervals (first, second, third, ... $\infty$ )" (see col.3 lines 52-54 and col.26 lines 25-26).



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Walls teaches of searching (see col.3 line 52), therefore searching corresponds to search requests of claims 1 and 13.

6. Claims 2-8 and 12, which depend on claim 1 and claims 14-20 and 24, which depend on claim 13, are still anticipated by Walls for the reasons set forth above.

7. Walls discloses of multiple search requests for both local and external documents as set forth above. Therefore Walls anticipates the invention as claimed in claims 25-31.

8. Claims 9 and 21, which depend on claims 7 & 1, and 19 & 13, respectively, are still rejected as being unpatentable by Walls and MacKenty.

Although, MacKenty discloses presenting auditory presentations of documents, he is actually converting SGML/XML documents into sound. MacKenty teaches that XML is a language, which augments contents with descriptions of what, the contents are and how they are to be used, which can be employed for categorizing in such a searching system of Walls (see col.1 lines 13-21).

9. Claims 11 and 10, which depend on claims 7 and 1, and claims 22 and 23, which depend on claims 19 and 13, are still rejected as being unpatentable by Walls and Rakavy. Walls teaches that the search report is in HTML, which is a language for viewing a web page of the Internet via a browser. Rakavy teaches that advertisements

may be displayed on web pages (see col.1 lines 29-30). Therefore, whether the advertisement is embedded in search reports, searched documents, or displayed, as it's own web page, it is a preference of the system implementor, and thus not an invention.

Note: Examiner must interpret the all the claims as broadly as it is worded within the scope of the claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

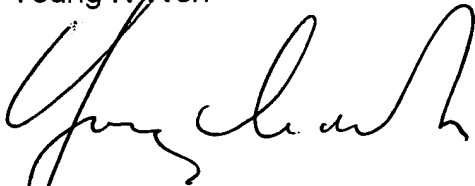
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-F: 8AM-4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3718 for regular communications and 703-305-5352 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won



June 24, 2002



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